THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN P. ARMANIE, ROBERTO J. RIOJA,
DIANA K. DENZER, CHARLES E. BROOKS, WALTER D. COKER,
DANIEL K. GADBERY and ROBERT NEWELL

Appeal No. 1996-1223
Application 08/218,676[1]

ON BRIEF

Before CAROFF, JOHN D. SMITH and WARREN, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1, 2, 4 through 14, 16 and 17 as amended subsequent to the final rejection.[2]

We have carefully considered the record before us, and based thereon, find that we cannot

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[1] Application for patent filed March 28, 1994.

[2] See the amendment of April 27, 1995 (Paper No. 7) which was entered by the examiner in the advisory action of May 15, 1995 (Paper No. 8) but has not been clerically processed.

sustain the rejection of all of the appealed claims under 35 U.S.C. § 103 as being unpatentable over Witters et al.[3] It is well settled that in order to establish a *prima facie* case of obviousness, "[b]oth the suggestion and the reasonable expectation of success must be found in the prior art and not in applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness is established by showing that some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally*, *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988). We agree with appellants that the examiner has failed to carry his burden of making out a *prima facie* case of obviousness with respect to the claimed invention.

There is no dispute that Witters et al. does not disclose the step of "pressing at least a portion of said billet which forms said low aspect ratio section along a tortuous path which includes deforming said aluminum-lithium alloy sequentially away from and toward the longitudinal mass center of the portion of said section having a low aspect ratio and thereafter extruding said portion through an extrusion die" as specified in appealed claim 1, similarly specified in claim 9 and embodied by a "spreader plate which obstructs the flow of the alloy into said at least one portion" as specified in claim 14, which embodiment is shown in specification FIG. 2. The sole evidence with respect to a spreader plate in the record on this appeal is the statement by Dr. Rioja in his declaration[4] that "[t]he use of spreader plates is known in the extrusion industry to meet design surface conditions for extrusions" (¶ 8). The examiner contends that "[t]he usage of a device such as a spreader plate in a well-known metallurgical process such as alloy extrusion would still produce improved alloy properties throughout the alloy workpiece because . . . [Witters et al.] teaches *preliminary working of the aluminum-*

[3] The reference is listed at page 2 of the answer.
[4] The "Rule 132 Declaration of Roberto J. Rioja" was filed on April 27, 1995 (Paper No. 5).

lithium alloy as a useful technique for obtaining the broad range of alloy properties depicted in Fig. 2 of the patent" (answer, page 7). We cannot agree with the examiner's position because, on this record, the examiner has not provided any evidence and/or scientific reasoning with respect to why one of ordinary skill in this art would have been motivated by the disclosure in Witters et al. to "preliminarily work the ingot without extruding to shape" (col. 5, lines 34-36) to modify the method of forming low aspect ratio aluminum-lithium extrusions disclosed in the reference by using a spreader plate, or any other means, to form a "tortuous path" having the characteristic stated in the appealed claims, prior to the extrusion die with the reasonable expectation of arriving at the methods of the appealed claims. Thus, it is manifest that the only direction to appellants' claimed invention as a whole on the record before us is supplied by appellants' own specification. *Fine, supra*; *Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531-32.

The examiner's decision is reversed.

Reversed

MARC L. CAROFF Administrative Patent Judge	)	
JOHN D. SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CHARLES F. WARREN Administrative Patent Judge	)	

Aluminum Company of America
ALCOA Technical Center
100 Technical Drive
Alcoa, PA 15069-0001